

### **REMARKS**

As a result of the above amendments, Claims 1-27 remain pending. Claims 1 and 15 have been amended. Applicant respectfully submits no new matter has been added. Accordingly, Claims 1-27 are at issue.

#### **Remarks Concerning the Drawings**

On page 2 of the March 1, 2005 Office Action, the Examiner did not approve amended Figure 2, which was submitted by Applicant in the communication dated December 7, 2004. The Examiner opined that the drawing included new matter which was not disclosed in the specification as originally filed. Without addressing the veracity of the Examiner's conclusion, and solely for the purpose of expediting the instant prosecution, Applicant hereby withdraws the proposed amendment to Figure 2.

#### **Remarks Concerning Claim 12**

On page 6 of the December 3, 2003 Office Action, the Examiner stated that the original Claim 12 contained allowable subject matter, if the claim were rewritten in independent form so as to include all of the limitations of the base claim. In the February 3, 2004 reply to that office action, Applicant amended Claim 12 in accordance with the Examiner's suggestion.

However, subsequent Office Actions (including the March 1, 2005 Office Action) have not specifically addressed the patentability of Claim 12. Notably, the Examiner has not specifically set forth any grounds of rejection of Claim 12 in any of the correspondence subsequent to the December 3, 2003 Office Action. Applicant therefore believes that in accordance with the Examiner's earlier determination, Claim 12 is in condition for allowance.

**Remarks Concerning the Information Disclosure Statement**

In ¶ 2 of the March 1, 2005 Office Action, the Examiner opined that the Information Disclosure Statement ("IDS") submitted by Applicant does not comply with the requirements of 37 C.F.R. § 1.97(c). Specifically, the IDS included neither a statement as required by 37 C.F.R. § 1.97(e) nor a fee as required by 37 C.F.R. § 1.17(p). Resubmitted herewith is an IDS, which discloses the same references as those included in the original IDS.

**Remarks Concerning Rejections Under 35 U.S.C. § 112**

In ¶¶ 3-4 of the March 1, 2005 Office Action, the Examiner rejected Claims 15-27 as failing to comply with the enablement requirement of 35 U.S.C. § 112 ¶ 1 and the definiteness requirement of 35 U.S.C. § 112 ¶ 2, respectively. The Examiner's rejections concern the term "training means" in Claim 15. Applicant respectfully maintains that the term "training means" is well defined in the specification. Specifically, the term "training means" is described on at least p. 6, line 24 et seq.; p. 7, lines 2-6 and 17-27; p. 8, lines 1-12.

Nonetheless, Claim 15 has been herein amended, such that the term "training means" has been replaced with "training resource", which is amply described on at least p. 5, lines 21 et seq. Applicant submits that the term "training resource" is an exemplary embodiment of the term "training means", and that the amendment does not alter the scope or meaning of Claim 15. Applicant further respectfully submits that the amendment satisfies and obviates the Examiner's rejections under 35 U.S.C. § 112.

**Remarks Concerning Rejections Under 35 U.S.C. § 103**

On page 4 of the March 1, 2005 Office Action, the Examiner rejected Claims 1-4, 6-11, 13-18 and 20-27 as being unpatentable over U.S. Patent No. 5,535,422 to Chiang et al. ("Chiang") in view of U.S. Patent Application Publication No. 2002/0059378 of Mustafa

("Mustafa"). In light of the amendments made herein to Claims 1 and 15, Applicant respectfully traverses the rejection.

Chiang is directed to an interactive online tutorial system for providing instruction in the use of software. The system includes two displays, a "tutorial window" and a "product window," where the tutorial window displays information relating to the segment of the product displayed in the product window. When a user of the Chiang system does not understand how to perform a task, the user can select a function that Chiang refers to as the "show-me function." When the user selects the "show-me function," the system performs the task (col. 18, lines 53 et seq.). Importantly, Chiang does not disclose that the *user* performs the task *with instruction* from the system. Chiang's "show-me function" directs *the system* to perform the task, which is entirely different from telling the *user* how to perform the task.

In the communication dated August 26, 1997, Applicant amended Claims 1 and 15 to clarify that in the present invention, the input to solve the programming difficulties is accomplished by programming input *from the user*. Chiang simply does not disclose that element. In fact, Chiang teaches directly away from that element, by requiring that the "show-me function" is performed entirely by the system, without user input at all.

The Examiner has taken Official Notice that "it is an old and well-known principle in the educational field that student's [sic] learn a task more efficiently when they perform the task, rather than by having the task performed for them" (e.g., p. 5, March 1, 2005 Office Action). By combining the Examiner's official observation with the Chiang system, the Examiner has reached the conclusion that the "walk-through" of the present invention is unpatentable over the "show-me" disclosed by Chiang. Applicant respectfully disagrees.

Even assuming the veracity of the Examiner's Official Notice, it is improper to combine that observation with a prior art reference when the prior art reference explicitly teaches away from that element. *In re Hedges*, 783 F.2d 1038, 1041 (Fed. Cir. 1986). In the present case, Chiang explicitly teaches that the programming task is performed *by the computer*, and the student is intended to learn by observing the computer's performance of the task. Chiang thus teaches directly away from the present invention, wherein the computer *shows the user how* to perform the task, and then requires the user to perform the task herself.

It is well recognized that if a proposal for modifying the prior art in an effort to attain the claimed invention causes the art to become inoperable or destroys its intended function, then the requisite motivation to make the modification would not have existed. *In re Fritch*, 972 F.2d 1260, 1265 n. 12 (Fed. Cir. 1992); *In re Gordon*, 733 F.2d 900, 901 (Fed. Cir. 1984); *In re Ratti*, 270 F.2d 810, 813 (C.C.P.A. 1959). The Examiner's proposed combination of the "show-me function" and the "show-the-student" technique is therefore legally improper, because the proposed modification would destroy the intended function of the "show-me function".

Mustafa does not cure the deficiencies of Chiang. Mustafa is directed to a system for interactively providing assistance to online clients. The Examiner has relied upon Mustafa solely for communicating information over a communications network (p. 4, March 1, 2005 Office Action). However, Mustafa does not overcome Chiang's lack of disclosure that the programming input comes *from the user*, as opposed to *from the system*. Neither Chiang nor Mustafa disclose that element, which is present in both Claim 1 and Claim 15.

Furthermore, Claims 1 and 15 have been herein amended to clarify that the system further records the difficulty encountered by the user. Support for that amendment is found in the specification at, for example, page 6. Applicant respectfully submits that neither Chiang nor Mustafa disclose this recording step.

Therefore, in light of the amendments made herein, Applicant respectfully submits Claims 1 and 15 are patentable over Chiang and Mustafa, and requests that the rejection be withdrawn and the claims allowed to issue. Claims 2-4, 6-11, 13-14, 16-18 and 20-27 are all dependent claims stemming from either Claim 1 or Claim 15, and for the same reasons, are patentable as well.

The Examiner has also rejected Claims 5 and 19 as being unpatentable over Chiang and Mustafa in further view of U.S. Patent No. 5,239,617 to Gardner et al. ("Gardner"), which is directed to an online, interactive help system which provides suggestions as to actions a user can take after entry into the system of an erroneous command or question. The Examiner has relied upon Gardner for information containing data indicating an error made by the user (p. 6, March 1, 2005 Office Action). Applicant respectfully traverses this rejection.

Like Chiang and Mustafa, Gardner does not disclose that the programming input comes from the user, and does not disclose that the user-encountered difficulty is recorded by the

Application No.: 09/818,006  
Attorney Docket No.: SAA-58 (402 P 340)  
Reply to Office Action of March 1, 2005

system. Applicant submits that the amendments made herein to Claims 1 and 15, on which Claims 5 and 19 respectfully depend, renders Claims 1 and 15 patentable over the cited references, and for the same reasons renders Claims 5 and 19 patentable as well. Accordingly, Applicant respectfully requests that the § 103 rejection therefore be withdrawn.

### CONCLUSION

In light of the amendments and remarks made herein, Applicant respectfully submits that Claims 1-27 are in condition for allowance. Applicant respectfully requests that the Examiner withdraw the rejections and allow the claims to issue. If it may be of assistance to contact the undersigned Attorney regarding the present invention, the Examiner is invited to do so. The Commissioner is hereby authorized to charge Deposit Account No. 23-0280 in connection with any fees associated herewith.

Respectfully submitted,

Dated: June 1, 2005

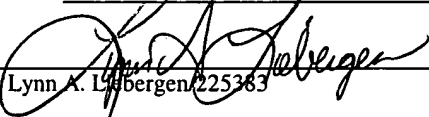
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**CERTIFICATE OF MAILING (37 C.F.R. § 1.8a)**

I hereby certify that this correspondence is, on the date shown below, being deposited with the United States Postal Service, with first class postage prepaid, in an envelope addressed to: Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on June 1, 2005

  
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